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09/506,407	02/17/2000	Masumi Senoo	10991381-1	7749
22879 7590 06/02/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
			EXAMINER EBRAHIMI DEHKORDY, SAIED	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MASUMI SENOO,  
KAZUO AOYAMA and SHAHZAD H. BHATTI

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Appeal 2007-3529  
Application 09/506,407<sup>1</sup>  
Technology Center 2600

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Decided: May 29, 2008

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Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT,  
and MARC S. HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of  
claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> Application filed February 17, 2000. The real party in interest is Hewlett-Packard Development Company, LP.

Appellants' invention relates to a system for creating and installing a menu structure in a printer (Spec. 1). The printer menu structure is installed on an erasable storage device in the printer (Spec. 2).

Claim 1 is exemplary:

1. A method of configuring a printer, the method comparing:

creating a printer menu structure; and

installing the printer menu structure on the printer, wherein the printer menu structure is installed on an erasable storage device in the printer.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ta	US 5,500,715	Mar. 19, 1996
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Claims 1-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ta.

Appellants contend that the applied reference (Ta) is concerned with selecting printer menu options, not creating and installing menu structures (Oct. 11, 2005, Reply Br. 3) and that printer menu selections are not equivalent to printer menu structures (Oct. 11, 2005, Reply Br. 4).

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Reply Brief<sup>2</sup> filed October 11, 2005, hereinafter

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<sup>2</sup> In response to the original Appeal Brief, filed May 23, 2005, the Examiner reopened prosecution and entered a new ground of rejection in a non-final rejection mailed August 11, 2005. Appellants, in the First Reply, noted that the rules do not seem to allow an Examiner's action reopening prosecution in response to an appeal brief, and construed the Examiner's action as an answer designating new grounds for rejection under 37 C.F.R. § 41.39(a)(2). Pursuant to § 41.39(b)(1), Appellants requested that the appeal be maintained by filing a reply brief under § 41.41.

referred to as the “First Reply,” the Examiner’s Answer (mailed April 21, 2006), and the Reply Brief (filed June 21, 2006), hereinafter referred to as the “Second Reply,” for their respective details.

### ISSUE

The principal issue in the appeal before us is whether the Examiner erred in holding that Ta teaches creating a printer menu structure and installing a printer menu structure on a printer.

### FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

#### *The Invention*

1. According to Appellants, they have invented a configurable printer menu structure. The printer user is able to determine the structure of the printer menu, select the font (and language) used to display the menu structure, and design and/or identify icons associated with various menu elements. In a particular embodiment of the invention, a printer is configured by creating a printer menu structure and installing the printer menu structure on the printer. The printer menu structure is installed on an erasable storage device in the printer (Spec. 2).

2. Appellants define “printer menu structure” in the Specification: A particular menu structure is typically contained in the printer. The menu structure provides the functions necessary to control or manage the operation of the printer. The user navigates the menu structure by pressing one or more buttons to select the

desired menu operation (such as resetting the printer, initiating a form feed operation, or selecting a particular font or template).

(Spec. 1).

*Ta*

3. Ta teaches an apparatus and method for selecting printer setup menu options which override both menu selections embedded in a print file on a diskette by a computer and printer default menu settings (col. 1, ll. 5-8), “to form a final set of printing instructions to a printer for a print job” (col. 3, ll. 31-33).

4. Ta teaches that “[o]nce the PC setup menu selections are made, they may thereafter be automatically handed to, embedded in and/or coupled with the print job interface code” (col. 8, ll. 2-4).

PRINCIPLES OF LAW

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

ANALYSIS

Claims 1-20 are argued as a single group. We select claim 1 as representative of this group, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

In the Examiner's view, Ta teaches creating a printer menu structure in that "the user is able to structure a print menu by selecting form [*sic*, from] the pc selection menu a set of desired or relevant option from the p set up menu" (Ans. 3, citing Ta Fig. 1, item 104 and col. 7, ll. 45-52). Ta is said to teach installing the printer menu structure on the computer, "where in the set up options structured or selected from the pc menu is put on the printer by inserting the diskette inside the printer" (Ans. 3, citing Ta Fig. 2, item 202 and col. 8, ll. 31-34). Last, the Examiner states that Ta teaches that the printer menu structure is installed on an erasable storage device in the printer (Ans. 3, the aforementioned diskette).

We begin by noting that Appellants' claim requires creating and installing a printer menu *structure*. Appellants provide a definition of "menu structure" at page 1 of the Specification:

A particular menu structure is typically contained in the printer. The menu structure provides the functions necessary to control or manage the operation of the printer. The user navigates the menu structure by pressing one or more buttons to select the desired menu operation (such as resetting the printer, initiating a form feed operation, or selecting a particular font or template).

(FF 2).

By contrast, Ta's invention is directed to "an apparatus for assembling printing option menu *selections* to form a final set of printing instructions to a printer for a print job" (FF 3). We fail to find any discussion whatsoever in Ta of creating or modifying the printer menu *structure*, which a user would use to navigate by pressing one or more buttons, nor of installing such a structure on a printer.

The Examiner argues that Ta teaches creating a printer menu structure (Ans. 3). The section of Ta cited by the Examiner describes Figure 1, which is a “block diagram of system 100 PC print menu selections” (col. 7, ll. 45-52). A user selects the “Print” command on a PC, and thereafter “*selects the desired and/or relevant options from the P set up menu*” (*id.*, emphasis added). The Examiner further asserts that Ta teaches “assembling printer option menu selections to form a final set of printing instructions to a printer for a print job” (Ans. 7; FF 3). We agree with Appellants, however, that there is nothing in this passage that even remotely suggests creating a printer menu structure, as the claim requires (Second Reply 4).

The Examiner argues that Ta teaches installing a printer menu structure on a printer (Ans. 3, citing Ta, col. 8, ll. 31-34). We agree with Appellants, however, who argue that this section of Ta discusses loading *selections* from a (preexisting) PC setup menu into the printer by inserting a diskette into the printer (Second Reply 5). We note that Ta teaches earlier in column 8 that “[o]nce the PC setup menu selections are made, they may thereafter be automatically handed to, embedded in and/or coupled with the print job interface code” (FF 4). We agree with Appellants that the cited passages in Ta do not teach or suggest installing a menu structure on a printer (Second Reply 5).

Because we do not agree with the Examiner that Ta teaches creating a printer menu structure, as the phrase is understood from Appellants’ Specification, nor installing a printer menu structure on a printer, we find that Ta does not teach every limitation of claim 1. We therefore find error in the Examiner’s rejection of claim 1, as well as claims 2-20, which recite “printer menu structure,” under 35 U.S.C. § 102.

CONCLUSION OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-20. On the record before us, Claims 1-20 have not been shown to be unpatentable.

DECISION

The Examiner's rejection of claims 1-20 is reversed.

REVERSED

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